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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,987	08/20/2003	Marybeth Ahern	00240293US	5154

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EXAMINER

KARDOS, NEIL R

ART UNIT	PAPER NUMBER
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3623

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03/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/643,987	Applicant(s) AHERN ET AL.	
	Examiner Neil R. Kardos	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 11-31 and 42-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 32-41, 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a non-final first Office action on the merits.

Claims 11-31 and 42-51 have been withdrawn from consideration.

Currently, claims 1-10, 32-41, and 52 are pending.

Election/Restrictions

2. Applicant's election without traverse of claims 1-10, 32-41, and 52 in the reply filed on February 11, 2008 is acknowledged.

Claim Objections

3. The numbering of the claims is objected to because claim 9 has been omitted from the original numbering. Note that when Examiner refers to claims 1-10 (or any such reference that would include claim 9), claim 9 is being excluded.

Examiner recommends that Applicant review the application file to determine whether a claim was omitted.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. **Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 52: Claim 52 recites “a computer program product comprising a computer usable medium having readable program code embodied in the medium, the computer program product includes” computer codes. It is not clear what the computer program product comprises. As claimed, the computer program product comprises a computer usable medium, and it also includes various codes. However, it is not clear that the code is tangibly embodied on the computer usable medium. It is not clear whether the claim is directed to software per se or software tangibly embodied on a computer-readable medium. Furthermore, because the claim does not specify that the code is computer-executable, the code could merely consist of text.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 32-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 32: Claim 32 recites a “system” comprising “components.”

These components do not necessarily make up a physical structure. Rather, they merely constitute procedures that do not require an accompanying structure. Such procedures, in a reasonably broad sense, are merely a collection of steps to be followed in order to achieve a desired outcome (i.e. a collection of computer instructions). In a reasonably broad sense, claim 32 is directed to computer instructions that lack any tangible structure. However, claim 32 does not tangibly embody this software on a computer-readable medium. The claim does not recite any physical structure that would serve to constitute a “system.”

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The dependent claims 33-41 are also rejected because they fail to add substantial limitations to remedy the deficiencies of the claims that they depend from.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-10, 32-41, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. pre-grant publication number 2003/0158800 to Pisello et al (“Pisello”) in view of Official Notice.**

Claims 1, 32 & 52: Pisello discloses a method, system, and computer program product for managing and tracking changes, the method comprising the steps of:

- identifying at least one capability to provide enhancement to enterprise architecture (see paragraph 30: lines 17-29, disclosing an IT project to enhance goals; paragraph 31, disclosing an example of an IT project to enhance enterprise architecture);
- estimating at least one of a revenue increase and a cost saving associated with the at least one capability (see paragraphs 33, disclosing costs related to IT projects; paragraph 39, disclosing costs and savings associated with the IT project; paragraph 43; paragraphs 51-55; paragraph 91); and

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- determining a value provided by the at least one capability based upon an implementation cost and the at least one of the revenue increase and the cost saving (see id.).

Pisello does not explicitly disclose defining at least one customer requirement for an enhancement to an enterprise architecture. Pisello does disclose, however, linking technology initiatives to shareholder value and communicating the value of IT investments to stakeholders (see paragraphs 3-4).

Examiner takes Official Notice that it was well-known in the business management arts at the time the invention was made to tailor business projects to customer requirements (see e.g. U.S. patent 6,411,936 to Sanders; U.S. patent 6,115,691 to Ulwick).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate well-known business management techniques into the method disclosed by Pisello in order to gear IT projects to customer needs. One of ordinary skill in the art would have been motivated to do so for the benefit of increasing business operating efficiency.

Claims 2, 33 & 34: Pisello discloses comparing the value provided by the at least one capability with another value provided by at least one other capability and determining which capability provides optimum value (see paragraph 91, disclosing comparing IT projects).

Pisello does not explicitly disclose mapping the at least one customer requirement to the at least one capability. Pisello does disclose, however, linking technology initiatives to shareholder value and communicating the value of IT investments to stakeholders (see paragraphs 3-4).

Examiner takes Official Notice that it was well-known in the business management arts at the time the invention was made to tailor business projects to customer requirements (see e.g. Pisello: paragraphs 3-4; see also U.S. patent 6,411,936 to Sanders; U.S. patent 6,115,691 to Ulwick).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate well-known business management techniques into the method disclosed by Pisello in order to gear IT projects to customer needs. One of ordinary skill in the art would have been motivated to do so for the benefit of increasing business operating efficiency.

Claim 3: Pisello discloses wherein the identifying step includes identifying one or more strategic resources to support the at least one capability (see paragraphs 33-34, 36-37, and 39, disclosing IT costs related to projects).

Claims 4 & 36: Pisello discloses wherein the identifying at least one capability step includes identifying at least one of a business process, a personnel skill/competency, a physical entity, an information technology, a system component, and an infrastructure component (see id., disclosing software, hardware, labor, etc.).

Claims 5 & 37: Pisello discloses assigning a weight to the one or more strategic resources and prioritizing the one or more strategic resources based on the assigned weight (see paragraph 34, disclosing assigning costs to resources for the project, which weigh into and prioritize the project that is eventually chosen; paragraphs 36, 40; paragraph 41, disclosing key performance indicators which constitutes a measure of IT improvement; furthermore, note that assigning a weight to items inherently prioritizes them).

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Claims 6 & 38: Pisello discloses assigning outcome based performance metrics to the one or more strategic resources (see paragraphs 41-47, disclosing KPI related to projects).

Claims 7 & 39: Pisello discloses implementing the one or more strategic resources (see paragraph 96).

Pisello does not explicitly disclose tracking the one or more strategic resources based on the outcome based performance metrics. Pisello does disclose, however, using KPI to measure performance (see paragraph 41).

Examiner takes Official Notice that it is well-known in the business management arts to track performance, for example using KPI.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate well-known business management techniques into the method disclosed by Pisello in order to track performance of implemented projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claims 8 & 40: Pisello discloses assigning a weight to the at least one capability and prioritizing the at least one capability based on the assigned weight (see paragraph 34, disclosing assigning costs to resources for the project, which weigh into and prioritize the project that is eventually chosen; paragraphs 36, 40; paragraph 41, disclosing key performance indicators which constitutes a measure of IT improvement; furthermore, note that assigning a weight to items inherently prioritizes them; paragraph 91).

Claims 10 & 41: Pisello discloses:

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- assigning outcome based performance metrics to the at least one capability (see paragraphs 41-47, disclosing KPI related to projects).; and
- implementing the at least one capability (see paragraph 96).

Pisello does not explicitly disclose tracking the at least one capability based on the outcome based performance metrics. Pisello does disclose, however, using KPI to measure performance (see paragraph 41).

Examiner takes Official Notice that it is well-known in the business management arts to track performance, for example using KPI.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate well-known business management techniques into the method disclosed by Pisello in order to track performance of implemented projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claim 35: Pisello discloses wherein the enterprise architecture includes at least one of a hardware architecture and a software architecture (see paragraphs 31, 33, and 39).

Additional Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. patent number 6,546,545 to Honarver et al, directed to rules-based decision management.

U.S. patent number 6,411,936 to Sanders, directed to enterprise value enhancement.

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U.S. patent number 6,393,406 to Eder, directed to valuing elements of a business enterprise.

U.S. patent number 6,115,691 to Ulwick, directed to strategy evaluation and optimization based on customer desired outcome and predictive metrics.

U.S. pre-grant publication number 2003/0120533 to Popillo et al, directed to increasing business productivity and revenues by identifying critical interactions relating to customers.

U.S. pre-grant publication number 2003/008456 to Ernest et al, directed to an automated information technology management system.

U.S. pre-grant publication number 2001/0034686 to Eder, directed to defining and measuring the real options of a commercial enterprise.

U.S. pre-grant publication number 2005/0086091 to Trumbly et al, directed to a business level metric for information technology.

U.S. pre-grant publication number 2004/0148566 to Jaffar et al, directed to evaluating project viability.

U.S. pre-grant publication number 2004/0034552 to Cole et al, directed to implementing a business process with a service provisioning model.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos
Examiner
Art Unit 3623

NRK
2/27/08

/Beth Van Doren/
Primary Examiner, Art Unit 3623